

## **REMARKS**

This amendment is filed together with a Request for Continued Examination pursuant to 37 C.F.R. § 1.114. After entry of the amendment, Claims 1, 3 to 23, 28, 29 and 32 remain pending.

Applicant wishes to thank the Examiner for the time and courtesy extended to Mr. Seder and his undersigned representative at the in-person interview held on May 22, 2008. The Examiner's cooperation in agreeing to meet to discuss the application after a final rejection is greatly appreciated.

### **Interview Summary**

Applicant discussed the nature of the invention, and how it distinguished over the prior art of record. Applicant also provided the Examiner with a proposed amendment that clarified the nature of the invention, and identified the reasons that the claimed subject matter is neither taught nor suggested by the cited art. The Examiner agreed that the proposed amendments would be considered if filed with an RCE, and would overcome the pending rejections under 35 U.S.C. § 103.

### **Amendments**

The claims have been amended herein as proposed to the Examiner at the interview. Specifically, claim 1 is amended to clarify that the claimed methods are directed to selecting an unraced racehorse candidate having a better than average likelihood of becoming a high earner. This amendment is supported throughout the application as filed, including, for example, at paragraphs [0002], [0013], [0093] and [0160]. Included in this disclosure is a definition for the term "high earner" as meaning a horse that raced at least 3 times and earned at least \$10,000 per start. Claim 1 has also been amended to recite that the collection of measurements comprises measurements for at least about 75 horses of about the same age, sex, and weight as said racehorse candidate. This amendment is supported, for example, by paragraph [0037] of the application as filed.

### **Pending Rejections**

The claims stand finally rejected under 35 U.S.C. § 103 as allegedly obvious over Young, LE, "Cardiac responses to training in 2-year-old Thoroughbreds: an echocardiographic study" (Young 1), in view of Young, LE, "Relative wall thickness: a

useful indicator of sports-specific cardiac adaptations to training in horses” (Young 2). As discussed at the interview, the methods set forth in the amended claims are neither taught nor suggested by either reference.

Young 1 is directed to a study designed to evaluate the effects of commercial racehorse training on cardiac dimensions and indices of cardiac function in 2 year old Thoroughbred racehorses (*see*, page 195, col. 2). The author reports that ventricular wall thickness, chamber diameter and relative wall thickness (“RWT”—an index of ventricular hypertrophy calculated by dividing the sum of left ventricular free wall and interventricular septal wall by the diameter of the left ventricle) all increased as an adaptive response to “a commercial training programme.” *See* p. 197, col. 1. No age-matched control group was analyzed, and the author suggests that the constraints of commercial training preclude the obtaining of such data (*see id.*). Nonetheless, the author concluded that commercial flat race training in horses produces adaptive responses of considerable magnitude (*see id.*, at page 198, col. 1), suggesting that measurements taken on their own, without correlation to training history, would be of little or no predictive value.

The instant claims, however, are directed to methods of selecting a racehorse candidate *prior* to the start of its racing career. Indeed, the methods are most often performed at yearling and two year old auctions, where horses have had little or no commercial race training. Thus, although Young 1 teaches that RWT increases in response to training, it says nothing about the predictive value of any cardiac measurement for predicting the likelihood of selecting a racehorse candidate that will be a high earner.

Young 2 relates to analyses of RWT in different type of equine athletes. The brief article reports that RWT values for endurance horses are less than those for racehorses, and also that among racehorses, sprinters tend to have higher RWT values than distance horses. Based on this data, the author concludes that RWT might be used to predict optimal race distances for Thoroughbreds. *See* Young 2, page 555, col. 1.<sup>1</sup> Thus, while Young 2 arguably indicates that certain RWT values may be correlated with sprinters versus distance horses, it does nothing to distinguish between good sprinters or distance runners and poor sprinters or

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<sup>1</sup> Notably, Young 2 reports that “there was no significant change in RWT with training in the group of flat-racing Thoroughbreds.” Thus, at least in this regard, the article appears to directly contradict the findings of Young 1.

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distance runners. Accordingly, there is nothing in Young 2 that would teach or suggest that RWT values for unraced racing candidates could be used to discriminate between future high earners and low earners. Accordingly, Young 2 does nothing to overcome the deficiencies of Young 2.

Moreover, as discussed during the interview, the Applicant has found that RWT is not a useful variable for predicting future racing success. In Applicant's methods, candidates may be selected if BOTH septal wall thickness and left ventricular cross-sectional area (which increases proportionally with left ventricular diameter) are greater than the mean values of each in horses of about the same age, sex, and weight (*see, e.g.*, claims 5 and 6). Young 1 and Young 2, on the other hand, teach that these values are inversely proportional to each other. While these values are *additive* in Applicant's methods, they cancel each other out in the RWT measurement described in the Young references.

Applicant thus reiterates the patentability analysis with regard to Young 1 and Young 2 discussed during the interview, an analysis with which the Examiner agreed. Accordingly, withdrawal of the rejections under 35 U.S.C § 103 is requested respectfully.

#### **CONCLUSION**

In view of the foregoing, a Notice of Allowance of all of pending claims 1 to 23, 28, 29 and 32 is earnestly solicited.

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